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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
1316N-001670

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On November 7, 2005Signature 

Typed or printed name Michael J. Schmidt

Application Number
10/662,547Filed
09/15/2003First Named Inventor
Simon Anne de MolinaArt Unit
3683Examiner
Christopher P. Schwartz

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor

Signature

 assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is
enclosed. (Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 _____

November 7, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

 *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

Application No.: 10/662,547
Filing Date: 09/15/2003
Applicant: Simon Anne de Molina
Group Art Unit: 3683
Examiner: Christopher P. Schwartz
Title: STROKE DEPENDENT DAMPING
Attorney Docket: 1316N-001670

PRE-APPEAL REVIEW

Sir:

The Examiner has rejected Claims 7-11 under 35 USC § 103(a) as being unpatentable over de Molina, et al. (USP 6,352,145) in view of Lee (USP 4,742,898) or Dressell, Jr., et al. (USP 4,133,415). Applicant respectfully traverses this rejection.

The Examiner's position is that de Molina, et al. discloses a shock absorber similar to the present invention but de Molina, et al. lacks showing a plurality of holes formed in a helical formation where the sleeve 78 sequentially covers the plurality of holes to progressively close the third flow path with the sleeve being operable to close the third flow path by covering the plurality of helically formed holes.

The Examiner first goes to Lee (USP 4,742,898) which discloses orifices at 34 where column 4 around line 40 states that the orifices 34 can be in a helical pattern. As clearly illustrated in Figures 1 and 2, the piston 72 in Lee does not have the ability to sequentially cover all of the holes to close a third flow path as is defined by Claim 7. Also, as discussed in Figure 3, bladder 16 does not cover holes 34 because retainer rails 108 and 110 limit the movement of bladder 16 (column 6, lines 19-32). When rod 74 strokes, piston heat 72 moves along cavity 98 with piston ring 81 passing each hole

34 to reduce the number of holes 34 located below piston head 72. As shown in Figure 2, piston ring 81 is positioned such that it cannot travel over the last hole 34 and thus Lee's system reduces the number of active holes by passing them and not by covering them as defined by the present invention and the system in Lee never has the capability of bypassing all of the holes and certainly does not have the capability to cover all of the holes as is defined in Claim 7.

The Examiner justifies his position by stating that it is notoriously well known in the art to provide dampers, as shown by de Molina, et al., with progressively covered holes as one well known means to regulate the damping characteristics. The problem here is that Lee does not progressively close holes and Lee lacks the capability of closing (or even bypassing) all of the holes.

A statement that modifications to the prior art to meet the claimed invention would have been "well within the ordinary skill of the art" at the time the claimed invention was made because the references relied upon teaching that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings *Ex parte Lovengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Here Lee does not teach a progressive closing of passages, it teaches progressively passing passages to reduce their number and it never reduces the number to zero. The Examiner's jump from progressively passing to reduce the number to the present invention of progressively closing passages and eventually closing all of the passages is clearly based on hindsight reasoning since it is clear that Lee does not progressively close passages.

The Examiner also attempts to use Dressell, Jr., et al. (USP 4,133,415) which the Examiner states is relied upon to provide a general teaching of the idea. Dressell, Jr., et al. discloses a spiral groove or channel that is progressively closed by sleeve 76. This closes radial ports 102. The sleeve 76 moves to progressively close grooves 86-90 and thus ports 102 but it does it by simultaneously closing all of the grooves 86-90 and thus all of the ports 102. The rotation of sleeve 76 does not sequentially close the grooves or the ports, it progressively closes them all simultaneously.

Thus, Applicant believes Claim 7, as well as dependent Claims 8-11, patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

The Examiner has rejected Claims 12-15 and 18 under 35 USC § 103(a) as being unpatentable over de Molina, et al. in view of Dressell, Jr., et al. or Schupner (USP 4,071,122). Applicant respectfully traverses this rejection.

The Examiner's position is that de Molina, et al. discloses a shock absorber similar to the present invention but de Molina, et al. lacks the showing of the third passageway comprised of a single hole and groove with a depth of the groove decreasing from the hole to a terminal end of the groove. The sleeve being able to fully cover the groove.

The Examiner first goes to Dressell, Jr., et al. to provide a general teaching of helical grooves with varying depth with holes which open into them. Please see in particular Figure 10 of Dressell, Jr., et al. Figure 10 of Dressell, Jr., et al. illustrates a spiral groove 132 which has a plurality of holes 134 extending from the groove. But, as illustrated in Figure 10 and defined in Dressell, Jr., et al. at column 2, lines 65 and 66,

"The grooves [spiral] are of a constant depth." Thus, it is clear that Dressell, Jr., et al. does not disclose, teach or suggest a helical spiral groove having a depth decreasing from the hole to the terminal end as defined by Claim 12. While Figures 6-8 of Dressell, Jr., et al. illustrate grooves 86-90 as having a decreasing depth, the grooves 86-90 are not spiral grooves they are circular grooves as shown in Figures 4-8. Thus, Dressell, Jr., et al. may teach circular grooves of variable depth and it may teach spiral grooves of constant depth but it does not teach spiral grooves of variable depth. In addition, the entire spiral groove 132 of Dressell, Jr., et al. is progressively closed simultaneously by the rotation of cylinder 20 and it is not progressively covered from the hole to the terminal end as is defined by Claim 12.

Schupner discloses a variable depth groove or slot but Schupner does not disclose a hole located at a base of a groove as is defined in Claim 12. Sleeve 11 is rotated to determine the position of slots 70-73 with respect to holes 47-50, but there is no progressive covering of the groove when movement of the piston rod exceeds a specified distance. Holes 47-50 are not located in the grooves, they are on a different component. In addition, the variable depth slot shown in Figures 1-4 is a circumferential slot and it is not a helical groove. Figures 5 and 6 of Schupner disclose helical grooves 70-73 but these helical grooves are uniform in cross-sectional size throughout their length as defined in column 3, lines 35 and 36. In fact, the paragraph in column 3 beginning at line 28 teaches that instead of having a circumferential slot which varies in cross-sectional size (as in Figure 4) the amount of slot exposed to the radial opening is varied. Thus, slots 70-73 are uniform in cross-sectional size throughout their length, however, they are slightly helical. Thus, Schupner teaches circular grooves with a

variable depth or helical grooves and a constant depth but not helical grooves with a variable depth.

Applicant asserts that the use of hindsight in picking and choosing isolated elements from various pieces of prior art is improper to the judicial standards governing the proper application of 35 USC § 103.

Thus, Applicant believes Claim 12, as well as dependent Claims 13-15 and 18, patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

By: 
Michael J. Schmidt, 34,007

Dated: November 7, 2005

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